

REMARKS

Applicants appreciate the indication of a grammatical error in claim 1, line 10 which is being corrected by the foregoing amendment.

Additionally, Applicants have deleted the resin "melamine-formaldehyde resin" from the definition of "thermosetting resin" in claim 1 and have emphasized that it is the presence of amino resin "in the ink" which increases the bonding more than could be achieved by the thermosetting resin alone. It is certainly clear that the term "thermosetting resin" is a term defined by the Markush group which provides the antecedent basis for this term in claim 1. Accordingly, in light of the foregoing none of the amendments raise the issue of new matter.

Reconsideration and withdrawal of the previous rejection of claims 10-14 and 18-20 under 35 USC §112, first paragraph is respectfully requested.

According to the Examiner's "interpretation" the Examiner alleges that there is no support in the original disclosure for a wear layer comprising a thermosetting resin selected from the group of melamine-formaldehyde resin, phenol-formaldehyde resin, urea-formaldehyde resin and mixtures thereof and additionally comprising an amino resin, an amino resin/cellulose mixture, or an amino resin impregnated cellulose layer or layers. This interpretation is clearly erroneous.

In this regard, Applicants direct the Examiner's attention to page 1, last paragraph of the specification which states that "the wear layer comprises a thermosetting resin selected from the group consisting of; melamine-formaldehyde resin, phenol-formaldehyde resin, urea formaldehyde resin and mixtures thereof". By the use of the term "comprises" it is clear that it is Applicants' intent that such wear layers did not necessarily consist of these materials but that other materials could indeed comprise part of the wear layer.

As further evidence, Applicants direct the Examiner's attention to the original claims, including independent claim 1, which recites this identical Markush group as found on page 1, last paragraph of the specification and, in addition, to dependent claim 10, directly dependent on claim 1. In dependent claim 10, it further states that

"the wear layer is comprised of a high viscosity amino resin applied on top of the decorative layer prior to the lamination".

If, as the Examiner suggests, the amino resin is used in place of, and not as a further component of the wear layer, then claim 10 would have had no meaning. It is obvious that Applicants did not intend that the amino resin comprise the sole resin of the wear layer. Not only does claim 10 support this interpretation but also the second full paragraph beginning at line 12 of page 2 of the specification in which it is stated that "the wear layer is according to one embodiment of the invention comprised of a high viscosity amino resin applied on top of the decorative layer prior to the lamination". Not only do Applicants not suggest that the wear layer consist of the amino resin, as suggested by the Examiner, but rather using the term "comprised of" means that other materials could exist in combination i.e., the thermosetting resins previously identified.

The same can be said of the other alternative components of the wear layer i.e., "an amino resin/cellulose mixture", again see e.g., the last paragraph on page 1 of the specification, page 2 lines 14-15 and original claim 11. For the "amino resin impregnated cellulose layer or layers" Applicants again direct the Examiner's attention to the specification, last paragraph on page 1, page 2 lines 15-16 and original claim 12.

Accordingly, Applicants respectfully submit that the Examiner's interpretation that the amino resin is used "in place of" the thermosetting resin identified in the Markush group, finds no support in the original disclosure and is an improper interpretation of the claimed subject matter. Having fully responded to the Examiner's allegations of failure to comply with the written description requirements of the first paragraph of 35 USC 112, withdrawal of the rejection is respectfully requested.

Reconsideration and withdrawal of the rejections of claims 1, 2, 4, 6, 7, 10-14 and 16-20 under 35 USC(a) for being unpatentable over Hansson (US Patent 6,565,919) in view of Sano (US Publication 2002/0077384) is respectfully

requested. Hanson '919 teaches a "wear layer constituted of one or more sheets of α -cellulose which are impregnated with melamine-formaldehyde resin" (Column 3, lines 54-57). By contrast, the claimed invention comprises a wear layer comprising a thermosetting resin selected from the group consisting of phenol-formaldehyde resin, urea-formaldehyde resin and mixtures thereof" none of which are melamine-formaldehyde resin.

In addition, Applicants use a printing ink in which the printing ink comprises an amino resin and it is the presence of the amino resin in the ink which increases the bonding more than can be achieved by the recited thermosetting resins of phenol-formaldehyde, urea formaldehyde and mixtures thereof. Accordingly, it is neither "inherent" nor obvious to achieve improved bonding by the use of the printing ink of Sano in the process of Hansson.

First, the Hansson wear layer is an amino resin i.e., melamine-formaldehyde and not phenol-formaldehyde, urea formaldehyde and mixtures thereof. Secondly, there is no disclosure that an amino resin in the printing ink will give a higher bonding to phenol-formaldehyde, urea formaldehyde and mixtures thereof which can be gleamed from the proposed combination of Hansson '919 and Sano because Hansson does not use the type of resins specifically recited in Applicants' claims.

Still further the use of a plurality of amino resin impregnated cellulose layer or layers, amino resin and or amino resin/cellulose mixtures as suggested by the Examiner in view of Hansson's teachings still would not teach the basic use of phenol-formaldehyde, urea formaldehyde and resins thereof as a wear layer in combination with a printing ink comprising an amino resin. Accordingly, none of this recited limitations of Applicants' claims are taught or made obvious by the proposed combination of Hansson '919 and Sano. Withdrawal of the rejection is therefore respectfully requested.

Reconsideration and withdrawal of the previous rejections of claims 8 and 9 under 35 USC 103(a) as being unpatentable over Hansson '919 and Sano as

applied above and further in view of Schultz (US Patent Publication 2003/0039810) is respectfully requested. Claims 8 and 9 are dependent upon claims which are subject only to a rejection based on the combination of Hansson '919 in view Sano. As Hansson '919 in view of Sano does not teach the limitations of the base claim upon which dependent claims 8 and 9 depend and as claims 8 and 9 contain all of the limitations of the claims upon which they depend (35 USC 112, fourth paragraph) these claims are also not properly rejectable over the proposed combination of Hansson '919 in view of Sano and Schultz. Schultz is only cited to show a paper layer suitable for ink jet printing and incorporation into decorative laminates; (see paragraph 7 of the preceding Office Action). The foregoing deficiencies in the proposed combination of Hansson '919 in view of Sano and Schultz does not establish a *prima facie* case of obviousness for the additional limitations of claims 8 and 9 in combination with the limitations in the claims from which they depend. Accordingly, withdrawal and rejection is respectfully requested.

Applicants thank the Examiner for the courtesy of the telephonic interview conducted on January 23, 2008 in which independent claim 1 and dependent claim 10 was discussed.

The Examiner indicated that the Amendment filed with the RCE would overcome the claim rejection in 35 USC 112, rejections, but it is noted in the foregoing Office Action that the Examiner has again raised the rejection under 35 USC 112, first paragraph. Applicants have fully responded to that rejection in the foregoing comments. Applicants noted that there is no teaching, suggestion, motivation, or expectation of success in combining a printing ink, such as taught in Sano, with Hanson '919. Although the Examiner has suggested that bonding improvement would be "inherent", Applicants have provided additional reasons in the foregoing response as to why there is "no inherency" in the proposed combination of Sano and Hansson '919. Hansson '919 uses different resins than those recited in the instant claims and it is clear that the instant specification teaches that there is an improved bonding for the use of an amino resin in a printing

ink and that this could be achieved by the use of a thermosetting resin recited in independent claim 1. Accordingly, although Applicants confirm the summary as set forth in the Examiner Interview Summary Record, by the foregoing Amendments and Remarks, Applicants have clearly distinguished the claimed invention from that of the proposed combination of references set forth in the Office Action and in addition clearly demonstrated that the original disclosure supports the invention as instantly claimed. Accordingly, withdrawal of all of the rejections and passing the application to issue is respectfully requested.

The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 14-1437, under Order No. 8688.046.US0000.

Respectfully submitted,



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